

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hemingway Huynh et al.

Application No.: 10/611,698

Filed: June 30, 2003

For: ADAPTIVE MEDIA MESSAGING,
SUCH AS FOR RICH MEDIA
MESSAGES INCORPORATING
DIGITAL CONTENT

Examiner: Michael Young Won

Art Unit: 2155

Confirmation No.: 4440

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APPELLANT'S APPEAL BRIEF

TO THE HONORABLE COMMISSIONER FOR PATENTS:

This is Appellant's Brief in support of a Notice of Appeal to the Board of Patent Appeals and Interferences filed on December 10, 2007, appealing the decision of the Examiner in the Final Office Action mailed October 9, 2007 ("Final Office Action"), in which the claims of the above-captioned application were again rejected. Appellant respectfully requests consideration of this Appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application.

I. REAL PARTY IN INTEREST

The real party in interest in the above-identified application is Prolifiq Software Inc. of Beaverton, OR, the current assignee of the above-identified application.

II. RELATED APPEALS

The Appellant's undersigned attorney and the assignee identified above are not aware of other appeals or interferences that would directly affect or be directly affected by, or have a bearing on the Board's decision in the subject Appeal.

III. STATUS OF THE CLAIMS

Claims 11 – 33 and 35 – 39 are cancelled.

Claims 1 – 10, 34, and 40 – 43 stand rejected under 35 U.S.C. § 103(a) and are presently appealed. In particular, these claims are rejected over Sahai et al. (U.S. Patent No. 6,594,699) (hereinafter “Sahai”) in view of Dunning et al. (U.S. Patent No. 7,024,485) (hereinafter “Dunning”).

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 is directed toward an article comprising a storage medium; and instructions stored therein. The instructions, when executed by a processor, will cause the processor to generate and transmit one or more messages to a receiving computer system. The one or more messages include a media message to be displayed on the receiving computer system as a first layer of an adaptive media message, the media message including a link; logic for testing digital content capabilities of the receiving computer system when the link is dereferenced; and logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system, such that the receiving computer system may display the selected version of the digital content in the media message as a second layer of the adaptive media message.

Support for the storage medium having instructions stored therein may be found at least in the first sentence of paragraph [0023]; memory 160 in Figure 1; and the last sentence of paragraph [0055]. Support for a processor executing the instructions in order to generate and transmit one or more messages to a receiving computer system may be

found at least in the first and third sentences of paragraph [0013]; CPU 171; and the first and second sentences of paragraph [0023]. Support for a media message, including a link, to be displayed on the receiving computer system as a first layer of an adaptive media message may be found at least in the IP message 200 of Figure 2; and the second, third, eighth, and ninth sentences of paragraph [0025]. Support for logic for testing digital content capabilities of the receiving computer system when the link is dereferenced may be found in at least test and select script(s) 320 of Figure 3; in the eighth and ninth sentences of paragraph [0025]; and the last sentence of paragraph [0026]. Support for logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system, such that the receiving computer system may display the selected version of the digital content in the media message as a second layer of the adaptive media message may be found in at least the test and select script(s) 320 of Figure 3; the replace script 430 of Figures 4 and 5; the replaced section 511 embodying selected layer in Figure 5; and the first sentence of paragraph [0030].

Claim 2 depends on claim 1 and introduces a claim element reciting that the instructions generate the one or more messages such that the logic is directly contained in the one or more messages. Support for this element is found at least in original claim 2; test and select script(s) 320 of Figures 3 - 5 and associated discussion including third sentence of paragraph [0026]; and replace script 430 of Figures 4 – 5 and associated discussion including the first sentence of paragraph [0030].

Claim 3 depends on claim 1 and introduces a claim element reciting that the instructions generate the one or more messages such that the logic is included in the one or more messages by reference. Support for this element is found at least in original claim 3; traversible link 213 of Figures 6 – 7 and associated discussion including second sentence of paragraph [0032]; test and select script(s) 610 of Figures 6 - 7 and associated discussion including fifth sentence of paragraph [0032]; and redirect link 620 of Figures 6 – 7 and associated discussion including the sixth sentence of paragraph [0032].

Claim 4 depends on claim 1 and introduces a claim element reciting that the instructions generate the one or more messages such that the selected one of the

plurality of versions of the digital content is not directly included in the media message as first transmitted to the receiving computer system, but is separately transferred under the control of the logic for displaying. Support for this element is found at least in the intial layer 210 of Figure 2 and the appended replace script of 430 of Figure 4 and associated discussion including the second sentence of paragraph [0025] and the first sentence of paragraph [0030].

Claim 5 depends on claim 1 and introduces a claim element reciting that the instructions generate the one or more messages such that the selected one of the plurality of versions of the digital content is downloaded by the logic for displaying, and is downloaded in a form customized for an addressee of the message. Support for this element is found at least in the second sentence of paragraph [0034].

Claim 40 depends on claim 1 and introduces a claim element reciting that the instructions generate the one or more messages such that the logic for testing digital content capabilities of the receiving computer system includes a script to be executed by the receiving computer system to test said digital content capabilities. Support for this element is found at least in the test and select script(s) 320 and associated discussion including the second through fourth sentences of paragraph [0026].

Independent claim 6 is directed toward a method in a computing system for presenting an adaptive message. The method includes receiving a message in the computing system including a link; displaying the message as a first layer of an adaptive media message; based on the contents of the received message: testing, when the link is dereferenced, two or more digital content capabilities of the computing system; selecting one of a plurality of different digital content elements based upon the results of the testing; and presenting the selected one of the plurality of different digital content elements within the message as a second layer of the adaptive media message.

Support for a computing system presenting an adaptive message is found at least in recipient computer system 150 of Figure 1 and the first sentence of paragraph [0022]. Support for receiving a message, including a link, to be displayed on the receiving computer system as a first layer of an adaptive media message may be found at least in the IP message 200 of Figure 2; and the second, third, eighth, and ninth sentences of paragraph [0025]. Support for testing, when the link is dereferenced, two or more digital

content capabilities of the computing system may be found in at least test and select script(s) 320 of Figure 3; the eighth and ninth sentences of paragraph [0025]; and the last sentence of paragraph [0026]. Support for selecting one of a plurality of different digital content elements based upon the results of the testing is found at least in test and select script(s) 320 of Figure 3; the eighth and ninth sentences of paragraph [0025]; and the last sentence of paragraph [0026]. Support for presenting the selected one of the plurality of different digital content elements within the message as a second layer of the adaptive media message may be found in at least the replace script 430 of Figures 4 and 5; the replaced section 511 embodying selected layer in Figure 5; and the first sentence of paragraph [0030].

Claim 8 depends on claim 6 and introduces a claim element reciting that the plurality of different digital content elements includes a video sequence and an animation sequence. Support for this element is found at least in the third and fourth sentences of paragraph [0014] and the last two sentences of paragraph [0038].

Claim 9 depends on independent claim 6 and introduces a claim element reciting that the plurality of different digital content elements, from which one is selected, includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player. Support for this element is found at least in the third and fourth sentences of paragraph [0014] and the last two sentences of paragraph [0038].

Claim 10 depends on claim 6 and introduces a claim element reciting that the selected one of the different digital content elements is selected based upon actions of a user of the computer system in connection with the received message. Support for this element is found at least in the second and third sentences of paragraph [0015] and the first and second sentences of paragraph [0052].

Independent claim 34 is directed toward an article comprising a storage medium; and instructions stored therein. The instructions, when executed by a processor, cause the processor to generate and transmit one or more messages to a receiving computer system, the one or more messages including a media message to be displayed on the receiving computer system as a first layer of an adaptive media message, the media message including a link; logic for testing capabilities of the receiving computer system

when the link is dereferenced; and logic for displaying a selected one of a plurality of versions of media content selected based on the results of testing capabilities of the receiving computer system, such that the receiving computer system may display the selected one of the plurality of versions of the media content in the media message as a second layer of the adaptive media message.

Support for the storage medium having instructions stored therein may be found at least in the first sentence of paragraph [0023]; memory 160 in Figure 1; and the last sentence of paragraph [0055]. Support for a processor executing the instructions in order to generate and transmit one or more messages to a receiving computer system may be found at least in the first and third sentences of paragraph [0013]; CPU 171; and the first and second sentences of paragraph [0023]. Support for a media message, including a link, to be displayed on the receiving computer system as a first layer of an adaptive media message may be found at least in the IP message 200 of Figure 2; and the second, third, eighth, and ninth sentences of paragraph [0025]. Support for logic for testing capabilities of the receiving computer system when the link is dereferenced may be found in at least test and select script(s) 320 of Figure 3; in the eighth and ninth sentences of paragraph [0025]; and the last sentence of paragraph [0026]. Support for logic for displaying a selected one of a plurality of versions of media content selected based on the results of testing capabilities of the receiving computer system, such that the receiving computer system may display the selected version of the media content in the media message as a second layer of the adaptive media message may be found in at least the test and select script(s) 320 of Figure 3; the replace script 430 of Figures 4 and 5; the replaced section 511 embodying selected layer in Figure 5; and the first sentence of paragraph [0030].

Claim 41 depends on claim 34 and introduces a claim element reciting that the instructions generate the one or more messages such that the logic for testing and the logic for displaying are appended to the media message. Support for this element is found at least in the test and select script(s) 320 and replace script 430 of Figures 4 and 5 and associated discussion including the second sentence of paragraph [0026] and the first sentence of paragraph [0030].

Claim 42 depends on claim 34 and introduces a claim element reciting that the instructions generate the one or more messages such that the media message further includes: a replaceable section to be replaced by a replacing section including the selected one of the plurality of versions of media content. Support for this element is found at least in the replaceable section 211 of Figures 2 – 4 and replaced section 511 of Figure 5 and associated discussion including sentence eight of paragraph [0025] and the second sentence of paragraph [0031].

Claim 43 depends on claim 42 and introduces a claim element reciting that the instructions generate the one or more messages such that the logic for displaying includes a replace script to replace the replaceable section of the media message with the replacing section. Support for this element is found at least in the replace script 430 of Figures 4 – 5 and associated discussion including the first sentence of paragraph [0030].

While specific examples of support are identified above, the specification may include a number of other bases for support for a given element.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-10, 34, and 40-43 are unpatentable under 35 U.S.C. § 103(a) over Sahai in view of Dunning.

VII. ARGUMENT

REJECTIONS UNDER 35 U.S.C. § 103

As is well established, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See MPEP 2142. To establish a *prima facie* conclusion of obviousness the factual basis must show (1) a sufficient reason to combine the teachings of the references; (2) a reasonable expectation of success; and (3) the combined teachings must teach or suggest all of the claim elements. The Supreme Court in *Graham v. John Deere Co.* set out the inquiries necessary to develop this factual basis. 383 U.S. 1, 17-18 (1966); see also MPEP 2141. These inquiries include determining the scope and content of the prior art and ascertaining the differences

between the prior art and the claims at issue.

The Examiner has clearly failed to provide a sufficient factual basis to support a *prima facie* case of obviousness of claims 1-10, 34, and 40-43 over any combination of the cited references.

A. Determining Scope and Content of Prior Art

Sahai teaches a client device that requests content through a scaling server and provides the scaling server with information on the client device's capabilities. This information may be provided to the scaling server along with the request or as a response to a query from the scaling server. Either way, the logic for testing the client device's capabilities resides on the client device. *Sahai* column 6, lines 9 – 11. The scaling server will then retrieve the requested content and adapt the content prior to delivery according to the client's capabilities.

Dunning teaches scalable coding of streaming content. Primary information is sent to a client first (which could be played at a low quality level) and then, as time permits, secondary information may be sent. The secondary information may be used in combination with the primary information to play the content at a high-quality level.

Dunning column 2, lines 52 – 61

B. Ascertaining the Differences between the Prior Art and the Claims at Issue

Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. See MPEP 2141.02.

Claim 34 of the present invention, recites an article comprising a storage medium and instructions, stored in the medium, which, when executed by a processor cause the processor to generate and transmit one or more messages to a receiving computer system. The one or more messages include:

a media message to be displayed on the receiving computer system as a first layer of an adaptive media message, the media message including a link;

logic for testing capabilities of the receiving computer system when the link is dereferenced; and

logic for displaying a selected one of a plurality of versions of media content selected based on the results of testing capabilities of the receiving computer

system, such that the receiving computer system may display the selected one of the plurality of versions of the media content in the media message as a second layer of the adaptive media message.

As can be seen, claim 34 clearly recites that the one or more messages include a media message to be displayed on the receiving computer system as a first layer of an adaptive media message. The media message will also have a link that, when dereferenced, results in the receiving computer system's capabilities being tested by logic included in the one or more messages. The one or more messages also includes logic for displaying an appropriate version of media content base on the results of the testing capabilities. In particular, the selected version of the media content may be displayed in the media message as a second layer of the adaptive media message.

The one or more messages, sent to the receiving computing system, have the capability of quickly displaying a first layer of an adaptive media message while obtaining information about the capabilities of the receiving computing system. The first layer of the adaptive media message may be designed to be easily viewed on most receiving computer systems. If, for example, the testing logic determines that a particular receiving computing system has sufficient capabilities, a higher-level version of the media content may be displayed within the media message as a second layer of the adaptive media message.

While the utility of such an embodiment is self evident, an example implementation is presented to elucidate the differences discussed below. Consider, for example, a firm engaged in a marketing effort. The firm may generate an adaptive media message, with a plurality of versions of media content, and transmit the adaptive media message to a large number of recipients. The adaptive media message, with the benefit of the teachings of embodiments of the present invention, will then adapt itself to the capabilities of the various receiving computing systems to provide an appropriate version of the adaptive media message. This adaptation may be done without requiring any *a priori* knowledge of the receiving computing system; without requiring any special intermediary infrastructure, e.g., scaling server; and/or without reliance on client-side utilities (e.g., testing logic stored on the client device).

The differences of the invention as recited in claim 34 and the combination of cited references at least includes the generation and transmission of one or more messages that include a media message, which is displayed as a first layer of an adaptive media message, having a link; and logic for testing capabilities of the receiving computer system when the link is dereferenced.

First, neither reference teaches or makes obvious a message that includes testing logic being sent to the receiving computer system. As stated above, Sahai only teaches that the testing logic is stored on the client computing device. There is no teaching or suggestion that the logic be transmitted to the receiving computing device, much less that the logic is tied to a dereferencing of a link transmitted with the first layer, discussed in further detail below. Dunning does not mention testing client capabilities at all.

Second, neither reference teaches or makes obvious inclusion of the link, which when dereferenced activates the testing logic, in the media message this is displayed as a first layer of an adaptive media message. The Examiner relies on both Sahai and Dunning to provide this teaching. In both references, the relied upon teaching discusses a user clicking on a URL to request content. This is clearly out of context as the links are not a part of the media message that is displayed as the first layer of the adaptive media message, nor do they activate the testing logic when dereferenced. The URL links of these references simply form the request for content. The Examiner's reliance upon these teachings in this manner clearly violates the mandate provided by *Diamond v. Diehr* that states "office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." 450 U.S. at 188-89. Instead, the claim as a whole must be considered. *Id.*

When considering the claim as a whole, it is clear that the first layer of the adaptive message has the link that activates testing logic, which is transmitted to the receiving computing device in the one or more messages. The activation of the testing logic may result in the message being adapted according to the tested capabilities of the receiving computer system.

The differences between claim 1 and the cited references are both significant and meaningful. These differences contribute to claim 1, as a whole, providing a media message that can be sent to a receiving computer system in a manner that allows for the

message itself to facilitate testing of, and adaptation to, the capabilities of the receiving environment. As is evident from the example given above, both Sahai and Dunning fail to teach or suggest systems that are capable of providing such an adaptive media message.

For at least these reasons, a person of ordinary skill in the art would not find claim 34, when considered as a whole, obvious in light of the cited references.

The remaining claims, e.g., claims 1 – 10 and 40 – 43 depend from, or include limitations similar to, claim 34. Accordingly, they are patentable over these references for at least the reasons given above. Some additional points of patentability will also be discussed below.

Claim 2

Claim 2 depends on claim 1 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 2 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the logic is directly contained in the one or more messages.

The Examiner relies upon Sahai column 6, lines 60 – 63 to teach this element. This portion of Sahai teaches that the server 10 can send an application to the client 12 to request information about the client capabilities. The “application sent by the server 10 to the client 12 is limited to asking (prompting) the user to supply capability information of the client...” This teaching would not be interpreted by one skilled in the art as “logic for testing capabilities” or “logic for displaying” as recited in claim 2. Accordingly, this claim is additionally patentable for at least this reason.

Claim 3

Claim 3 depends on claim 1 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 3 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the logic is included in the one or more messages by reference.

The Examiner relies upon Sahai column 8, lines 45 – 47 to teach this element. This portion of Sahai is a claim fragment that recites that client media capabilities are stored in a storage location accessible by a process. Storing client media capabilities is not the same as including, by reference, logic for testing and/or displaying in one or more messages transmitted to a receiving computer system. Accordingly, this claim is additionally patentable for at least this reason.

Claim 4

Claim 4 depends on claim 1 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 4 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the selected one of the plurality of versions of the digital content is not directly included in the media message as first transmitted to the receiving computer system, but is separately transferred under the control of the logic for displaying.

The Examiner relies upon Sahai column 3, lines 15 – 19 to teach this element. This portion of Sahai teaches that every time a client requests a URL, the server 10 needs to determine if it has capabilities stored for the requesting client. The Applicants are confused as to any relevance of this teaching to the element cited in claim 4. It does not discuss or imply selected versions of digital content being transferred, separate from media message as first transmitted, under control of logic for displaying (which is included in the one or more messages transmitted to the receiving computer system). Accordingly, this claim is additionally patentable for at least this reason.

Claim 5

Claim 5 depends on claim 1 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 5 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the selected one of the plurality of versions of the digital content is downloaded by the logic for displaying, and is downloaded in a form customized for an addressee of the message.

The Examiner relies upon Sahai column 5, lines 41 – 46 to teach this element. This portion of Sahai teaches that the media server adapts media and streams it to the client. A player on the client then plays the media as it is received. A person of ordinary skill in the art would interpret “customized for an addressee of the message” to be different than customizing media for a receiving computing device (based on capabilities of the device). The Applicants’ specification talks in depth about adapting a message based on device capabilities. It also sufficiently draws the distinction that customizing content for an addressee is done to personalize the content to the recipient (e.g., by including name, adapting content based on recipient’s past actions, etc.). Consider, e.g., if two adaptive media messages were sent to two different recipients but accessed on the same computer. Customizing the messages for the addressees, as recited in claim 5, may result in the messages having different content. However, customizing the content based on the capabilities of the computer would provide identical versions. Accordingly, this claim is additionally patentable for at least this reason.

Claim 8

Claim 8 depends on claim 6 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 8 also presents additional points of patentability by introducing a claim element reciting that the plurality of different digital content elements includes a video sequence and an animation sequence.

The Examiner relies upon Sahai column 3, lines 57 – 60, and column 4, lines 25 - 27 to teach this element. This portion of Sahai teaches, at best, that the client has multiple media players. Again, the Examiner has read a claim element in isolation and failed to take into account the appropriate context in which the element is presented. In this instance, the element added by claim 8 must be read in light of the context provided by the independent claim from which it depends, i.e., claim 6. Reading this element in its appropriate context makes it clear that a digital content element is selected from at least two different types of digital content elements (i.e., a video sequence and an animation sequence) based upon results of testing capabilities of the computing system. So, for example, if a system test reveals that the system has an animation player but not a video player, the animation sequence may be selected. See, for example, paragraph [0038].

This provides additional flexibility in that a theme/message of an adaptive media message may be presented in any of a variety of alternative forms depending on the particular platform on which it is presented. Therefore, Sahai's alleged teaching that a client has multiple media players fails to teach or suggest selection between alternative media types for a particular adaptive media message as recited in claim 8. Accordingly, this claim is additionally patentable for at least this reason.

Claim 9

Claim 9 depends on claim 6 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 9 also presents additional points of patentability by introducing a claim element reciting that the plurality of different digital content elements, from which one is selected, includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player.

In the Final Office Action, the Examiner states that this element is implicitly provided at *Sahai* column 3, lines 34-40. Similar to the sections cited with reference to claim 8, this portion of Sahai teaches, at best, that the client has multiple media players. Similar to the discussion above with respect to claim 8, Sahai fails to teach or suggest selection between digital content elements constructed for playing on different players, for a particular adaptive media message. Accordingly, this claim is additionally patentable for at least this reason.

Claim 10

Claim 10 depends on claim 6 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 10 also presents additional points of patentability by introducing a claim element reciting that the selected one of the different digital content elements is selected based upon actions of a user of the computer system in connection with the received message.

The Examiner relies upon Sahai column 2, lines 16 – 18 and column 3, lines 46 – 49 to teach this element. These portions of Sahai teach that the server 10 optimizes playback of an asset based on client capabilities and user specifications or preferences

(e.g., which port to use). However, this claim element clearly recites that the actions of the user, upon which selection is based, are in connection with the received message. In Sahai, a user setting up delivery preferences must take place prior to delivery. Therefore, these actions are not actions in connection with the received message as recited in claim 10. Accordingly, this claim is additionally patentable for at least this reason.

Claim 40

Claim 40 depends on claim 1 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 40 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the logic for testing digital content capabilities of the receiving computer system includes a script to be executed by the receiving computer system to test said digital content capabilities.

The Examiner relies upon Sahai column 5, lines 26 – 31 to teach this element. This portion of Sahai teaches that the server processes a browser request using a CGI binary script and sends a reply to the client browser that references the type of data that is to be sent. Other than the use of the term “script” this teaching has no relevance to the element presented in claim 40, which recites that the testing logic includes a script to be executed by the receiving computer system. Accordingly, this claim is additionally patentable for at least this reason.

Claim 41

Claim 41 depends on claim 34 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 41 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the logic for testing and the logic for displaying are appended to the media message.

The Examiner relies upon Sahai column 2, lines 26 – 28 to teach this element. This portion of Sahai teaches that client capabilities may be obtained by querying the client, or by the client sending capabilities along with a request for content. The

Examiner makes no effort to articulate an interpretation of these portions that could reasonably teach or suggest the element of claim 41. These teachings do not even teach or suggest sending testing logic to the client, much less appending the logic to a media message. Accordingly, this claim is additionally patentable for at least this reason.

Claim 42

Claim 42 depends on claim 34 and is patentable for at least the reasons given above with respect to the underlying claim. Claim 42 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the media message further includes: a replaceable section to be replaced by a replacing section including the selected one of the plurality of versions of media content.

The Examiner relies upon Dunning column 10, lines 43 – 51 to teach this element. This portion of Dunning teaches that the low-quality version may be output in lieu of the high-quality version, or vice versa. If the high-quality version is presented, secondary information will be presented in conjunction with the primary information. This is an additive process, not a replacing one. Therefore, this portion would not be interpreted as teaching or suggesting a replaceable section to be replaced by a replacing section including the selected media content as recited in claim 42. Accordingly, this claim is additionally patentable for at least this reason.

Claim 43

Claim 43 depends on claim 42 and is patentable for at least the reasons given above with respect to the underlying claims. Claim 43 also presents additional points of patentability by introducing a claim element reciting that the instructions generate the one or more messages such that the logic for displaying includes a replace script to replace the replaceable section of the media message with the replacing section.

The Examiner relies upon Sahai column 5, lines 26 – 31 to teach this element. This portion of Sahai teaches that the server processes a browser request using a CGI binary script and sends a reply to the client browser that references the type of data that is to be sent. Other than the use of the term “script” this teaching has no relevance to the

element presented in claim 43, which recites that logic for displaying includes a replace script to replace the replaceable section. First, as discussed with reference to claim 42, there is no replaceable section in Dunning. Second, the script referred to in this portion operates on the server (it is not in the messages sent to the client). Third, the script operates to process a request from the client, it does not operate to replace a replaceable section. Accordingly, this claim is additionally patentable for at least these reasons.

VIII. – X. APPENDICES

The appendices are presented at the end of this paper.

XI. CONCLUSION

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted with an authorization to charge Deposit Account No. 500393 to cover an appeal fee of \$255 for a small entity as specified in 37 C.F.R. § 1.17(c). We do not believe any other fees are needed. However, should that be necessary, please charge them to the deposit account listed above. In addition, please credit any overages to the same account.

SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: March 13, 2008

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VIII. CLAIMS APPENDIX

1. (Previously presented) An article comprising:
 - a storage medium; and
 - instructions stored in the storage medium, which, when executed by a processor, cause the processor to generate and transmit one or more messages to a receiving computer system, the one or more messages including
 - a media message to be displayed on the receiving computer system as a first layer of an adaptive media message, the media message including a link;
 - logic for testing digital content capabilities of the receiving computer system when the link is dereferenced; and
 - logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system, such that the receiving computer system may display the selected version of the digital content in the media message as a second layer of the adaptive media message.
2. (Previously presented) The article of claim 1, wherein the instructions, when executed by the processor, generate the one or more messages such that the logic is directly contained in the one or more messages.
3. (Previously presented) The article of claim 1, wherein the instructions, when executed by the processor, generate the one or more messages such that the logic is included in the one or more messages by reference.

4. (Previously presented) The article of claim 1, wherein the instructions, when executed by the processor, generate the one or more messages such that the selected one of the plurality of versions of the digital content is not directly included in the media message as first transmitted to the receiving computer system, but is separately transferred under the control of the logic for displaying.

5. (Previously presented) The article of claim 1, wherein the instructions, when executed by the processor, generate the one or more messages such that the selected one of the plurality of versions of the digital content is downloaded by the logic for displaying, and is downloaded in a form customized for an addressee of the message.

6. (Previously presented) A method in a computing system for presenting an adaptive message, comprising:

receiving a message in the computing system including a link;
displaying the message as a first layer of an adaptive media message;
based on the contents of the received message: testing, when the link is dereferenced, two or more digital content capabilities of the computing system; selecting one of a plurality of different digital content elements based upon the results of the testing; and presenting the selected one of the plurality of different digital content elements within the message as a second layer of the adaptive media message.

7. (Previously presented) The method of claim 6 wherein the plurality of different

digital content elements includes a high-quality video sequence and a low-quality video sequence.

8. (Previously presented) The method of claim 6 wherein the plurality of different digital content elements includes a video sequence and an animation sequence.

9. (Previously presented) The method of claim 6 wherein the plurality of different digital content elements includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player.

10. (Previously presented) The method of claim 6 wherein the selected one of the different digital content elements is selected based upon actions of a user of the computer system in connection with the received message.

11. – 33. (Cancelled)

34. (Previously presented) An article comprising:
a storage medium; and
instructions stored in the storage medium, which, when executed by a processor, cause the processor to generate and transmit one or more messages to a receiving computer system, the one or more messages including
a media message to be displayed on the receiving computer system as a

first layer of an adaptive media message, the media message including a link; logic for testing capabilities of the receiving computer system when the link is dereferenced; and

logic for displaying a selected one of a plurality of versions of media content selected based on the results of testing capabilities of the receiving computer system, such that the receiving computer system may display the selected one of the plurality of versions of the media content in the media message as a second layer of the adaptive media message.

35. – 39. (Cancelled)

40. (Previously presented) The article of claim 1, wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for testing digital content capabilities of the receiving computer system includes a script to be executed by the receiving computer system to test said digital content capabilities.

41. (Previously presented) The article of claim 34, wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for testing and the logic for displaying are appended to the media message.

42. (Previously presented) The article of claim 34, wherein the instructions, when executed by the processor, generate the one or more messages such that the media message further includes:

a replaceable section to be replaced by a replacing section including the selected one of the plurality of versions of media content.

43. (Previously presented) The article of claim 42, wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for displaying includes a replace script to replace the replaceable section of the media message with the replacing section.

IX. EVIDENCE APPENDIX

There is no evidence to present in an evidence appendix.

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings decisions to present in a related proceedings appendix.